

Appl. No. 09/898,880  
Reply Dated Nov. 6, 2003  
Reply to Office Action of Aug. 6, 2003

### **REMARKS**

Claims 20-25 are pending in the present application and stand rejected. Claims 1-19 have been withdrawn from consideration.

### **INVENTION SYNOPSIS**

The present invention relates to a disposable absorbent article having a film-forming composition disposed on at least a skin-contacting surface of the absorbent article, wherein the composition is substantially anhydrous and is solid or semi-solid at room temperature. The composition comprises (a) from about 1 to about 80 wt% of a skin conditioning agent selected from the group consisting of petroleum based emollients; fatty acid esters; polysiloxanes; polyol polyesters; esters or ethers of polyhydroxy alcohols; fatty alcohol esters of polyprotic acids; animal oils, fats, and their derivatives; vegetable oils, hydrogenated vegetable oils, and their derivatives; branched hydrocarbons; fatty alcohol ethers; free sterols, sterol esters and their derivatives; sphingolipids; phospholipids; and mixtures thereof; (b) from about 15 to about 50 wt% of a viscosity enhancing agent selected from the group consisting of C12-C60 alcohols, waxes, fumed silicas, and mixtures thereof; (c) from about 1 to about 20 wt% of a film-forming agent selected from the group consisting of polyalkenes, PVP/alpha-olefin copolymers, acrylic copolymers, and mixtures thereof; and (d) optionally, from about 0.01 to about 10 wt% of a skin care ingredient selected from the group consisting of Monographed I actives, Monographed III actives, vitamins, proton donating agents, protease inhibitors, enzyme inhibitors, chelating agents, anti-microbials, skin soothing agents, and mixtures thereof; wherein the composition is resistant to water, wash-off, and rub-off.

Applicants have found that the claimed composition forms a film that adheres to the skin. The film contains beneficial skin care ingredients and skin conditioning agents that are then held in intimate and prolonged contact with the skin such that they are able to provide benefit to the skin.

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REJECTION UNDER 35 U.S.C. § 103(a)

Claims 20-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,609,587 to Roe (hereafter "Roe") and in view of Wenninger, et al. (*Int. Cos. Ingrid. Dict. And Hand.* 1997) (hereafter "Wenninger"). In support of this rejection, the Office reasons that Roe discloses the same composition components as claimed by Applicants. In particular, the Office presents that Roe discloses film-forming agents as an optional component. The Office acknowledges that Roe does not teach the specific film forming agents as claimed by Applicants. Wenninger, as presented by the Office, discloses acrylates copolymers and polyethylene as film forming agents. The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the acrylates copolymers and polyethylene of Wenninger in the invention of Roe. The Office further states it is obvious to combine these references in light of Roe which states "all of these materials are well known in the art as additives for such formulations and can be employed in appropriate amounts in the lotion compositions of the present invention." Applicants respectfully traverse this rejection.

Applicants submit that Claims 20-25 are not rendered obvious over Roe in view of Wenninger. Roe relates to a diaper containing a liquid pervious topsheet coated with a lotion composition. The lotion composition reduces the adherence of BM to the skin of the wearer, thereby improving the ease of BM cleanup, and improves skin softness. The lotion composition disclosed therein comprises a liquid polyol polyester and an immobilizing agent such as a fatty alcohol or paraffin wax to immobilize the liquid polyol polyester on the surface of the diaper topsheet. The polyol polyester(s) remain at or near the skin surface, providing the desired BM cleaning and/or therapeutic benefits. In particular, Roe discloses a diaper having a lotioned topsheet comprising a liquid polyol polyester emollient and an immobilizing agent. The disposable absorbent article can be sanitary napkins, panty-liners, diapers, incontinence briefs, etc. Roe also discloses that the lotion composition comprises (1) a liquid polyol polyester emollient; (2) an immobilizing agent(s) for the liquid polyol polyester emollient; (3) optionally, a hydrophilic surfactant; and (4) other optional components.

Wenninger is a cosmetic ingredient dictionary and handbook that discloses acrylates copolymers, polyethylene, and hundreds of other compounds as film-forming agents.

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Applicants submit that the Office has failed to establish a prima facie case of obviousness and, as a result, Claims 20-25 should be allowed as previously presented. Applicants point to several errors in the Office's asserted prima facie case of obviousness.

First, Roe, Wenninger, nor the combination of the two teach or suggest all of the limitations within Claims 20-25. To establish a prima facie case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicants believe that the Office failed to consider the amendment to Claim 20 as made in the response/amendment dated July 2, 2003. As previously amended, Claim 20 recites the limitation of a film-forming composition "wherein the composition is resistant to water, wash-off, and rub-off." Roe and Wenninger fail to teach or suggest a composition that is resistant to water, wash-off, and rub-off. Likewise, the hypothetical combination of Roe and Wenninger provides no teaching or suggestion of resistance to water, wash-off, or rub-off. As a result, the Examiner has failed to make a prima facie case of obvious since all claimed limitations are not recited in the references. Since independent Claim 20 is nonobvious in light of the reasoning above, Claims 21-25 depending therefrom are also nonobvious. *In re Fine*, 837 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Second, Roe teaches away from Applicants' claimed invention. Claim 20 recites a film-forming composition "wherein the composition is resistant to water, wash-off, and rub-off." Roe discloses that "it is important that the lotion composition also be sufficiently wettable to ensure that liquids will transfer through the topsheet." Col. 21, lines 44-46. To provide wettability to the lotion composition of Roe, an optional hydrophilic surfactant may be employed. The option of using the hydrophilic surfactant is dependent, in part, upon the immobilizing agent used. Roe states that "immobilizing agents such as C<sub>16</sub>-C<sub>18</sub> fatty alcohols having HLB (hydrophilic-lipophilic balance) values below about 7 will *require* addition of hydrophilic surfactant to improve wettability." Col. 21, lines 57-59 (emphasis added). The Office asserts that the viscosity enhancing agents (e.g., C<sub>12</sub>-C<sub>60</sub> alcohols and waxes in particular) of Applicants' invention are the same as the immobilizing agents of Roe. With such an assertion, the Office must also accept that, with the use of fatty alcohols as the immobilizing agents, the composition of Roe also requires the use of hydrophilic surfactants to increase wettability. However, wettability is clearly not desired in Applicants' invention. Applicants' Claim 20 requires the

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composition to be resistant to water and substantially anhydrous. Roe would not be resistant to water since a hydrophilic surfactant is required when using the said immobilizing agents. Case law clearly states, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). The Office has selectively chosen portions of Roe without a full appreciation of what Roe teaches. Roe, with its use of a hydrophilic surfactant, does not suggest the Applicants' claimed invention which is water resistant and substantially anhydrous.

Third, case law clearly supports the rule that a claimed species or subgenus encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. See *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994). Such is the case in the present application. Roe discloses a genus of chemical compounds that can be optionally used in a lotion composition. In particular, Roe discloses the genus of film formers. Applicants identify three discrete compounds (i.e., polyalkenes, PVP/alpha-olefin copolymers, acrylic copolymers, and mixtures thereof) that may be used as film forming agents. Roe's disclosure of the genus of film formers is not sufficient by itself to establish a prima facie case of obvious.

The Office offers Wenninger as a reference teaching the use of acrylates copolymer and polyethylene as film formers. Furthermore, the Office states, "With respect to the specific film forming agents as claimed by the applicant, it is the position of the examiner that the disclosure of film formers is directed to a broad category and that all compounds that are film formers fall within its scope." While Wenninger does disclose acrylates copolymer and polyethylene as being film formers, Wenninger is a dictionary listing all compounds that may function as a film formers within a cosmetic, toiletry, or fragrance. Essentially, Wenninger discloses nothing more than the genus of film formers, albeit by defining the genus by every possible species. Applicants assert that the Office has substituted the genus presented in Wenninger for the genus presented in Roe. As a result, the basis for the rejection of a particular species is still improperly based upon the disclosure of a genus.

Fourth, "there should be something in the prior art or a convincing line of reasoning . . . suggesting the desirability of combining the references in such a manner as to arrive as the

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claimed invention.” *Ex parte Hiyamizu*, 10 USPQ2d 1993 (BPAI 1988). Furthermore, “it is well settled that that where the claimed invention solves a problem, the discovery of the source of the problem and its solution are considered to be part of the invention as a whole under 35 U.S.C. § 103.” *Ex parte Hiyamizu*, 10 USPQ2d 1993 (BPAI 1988); *See also In re Kaslow*, 707 F.2d 1366 (Fed. Cir. 1983), *In re Spinnoble*, 405 F.2d 578 (CCPA 1979). By combining these requirements, the references cited or a line of reasoning must exist showing the desirability of combining the references to arrive at the claimed invention, which includes the discovery of the source and solution of a problem.

Upon review of the references cited by the Office, neither Roe nor Wenninger teach or suggest the problem or possible causes of the problem addressed by Applicants. Discovery of the source of the problem is part of the “subject matter as a whole and should be considered in determining the obviousness of the inventions. *In re Spinnoble*, 405 F.2d 578 (CCPA 1979). Specifically, Applicants identify the **problem** of providing compositions that “have good affinity to the skin and are resistant to rub-off or wash-off such that they provide long-lasting barrier protection to the skin.” *See* specification page 1, lines 24-25. The **source** of the problem is that existing compositions fail for various reasons. Compositions with emulsion type carriers exacerbate the overhydration problem of diapered skin. *See* page 1, lines 25-28. Compositions with volatile carriers may irritate the skin. *See* page 1, line 30. Compositions containing anhydrous substantive carriers have a greasy or tacky feel and tend to transfer onto and stain clothing. *See* page 1, lines 31-33. Applicants provide the **solution** in that the “film forming nature of the present composition provides good affinity to the skin such that the composition is resistant to wash-off or rub-off.” *See* page 3, lines 28-30. Further, Applicants provide that “[t]he film-forming agents enhance the adherence of the composition to the skin and render the composition resistance (sic) to wash-off or rub-off.” *See* page 12, lines 32-33.

The Office fails to point to something in the references cited or to present a line of reasoning showing the desirability of combining Roe and Wenninger to arrive at Applicants’ claimed invention, which includes the discovery of the source and solution to the problem of providing compositions that “have good affinity to the skin and are resistant to rub-off or wash-off such that they provide long-lasting barrier protection to the skin.” As a result, the Office has failed to make a prima facie case of obviousness.

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### CONCLUSION

Based on the foregoing reasons, Applicants respectfully submit that the Office has not made prima facie case of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested.

Respectfully Submitted,

For: **T. J. Klofta, et al.**

By 

Eric T. Addington  
Agent for Applicants  
Registration No. 52,403  
Tel. No. (513) 626-1602

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Customer No. 27752